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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/646,609	08/22/2003	Allen C. Buhler	BUTR-101US	9808
24314	7590	03/22/2006	EXAMINER	
JANSSON, SHUPE, MUNGER & ANTARAMIAN, LTD 245 MAIN STREET RACINE, WI 53403			PEARSE, ADEPEJU OMOLOLA	
			ART UNIT	PAPER NUMBER
			1761	
DATE MAILED: 03/22/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/646,609

Applicant(s)

BUHLER ET AL.

Examiner

Adepeju Pearse

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) 31-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-30, drawn to low-calorie low-fat butter flavored composition, classified in class 426, subclass 564.
 - II. Claims 31-44, drawn to a method of preparing a water-based low-calorie low-fat butter-flavored composition, classified in class 426, subclass 520. The inventions are distinct, each from the other because of the following reasons:
2. Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by a materially different process and does not require the specific formulation of coloring, pressurizing, etc. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
3. During a telephone conversation with Mr. Peter Jansson on 2/06/2006 a provisional election was made with traverse to prosecute the invention of group I, claims 1-30. Affirmation of this election must be made by applicant in replying to this Office action. Claims 31-44 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Specification

4. The use of the trademark DURATAN, DURFAX, DUREM, MALTRIN, AVICEL, has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner, which might adversely affect their validity as trademarks.

5. The disclosure is objected to because of the following informalities: On page 3 line 21, missing data between the word “strength” and “times”. On page 6 lines 23 and 25, missing data between “about” and “parts”. On page 13 line 14, it is unclear what “interface acting??” is. On page 14 lines 8 and 12 contain the phrase “how much” between “water” and “at” and “water” and “is”. Appropriate correction is required.

Claim Objections

6. Claim 16 is objected to because of the following informalities: The claim recites a nonionic lipophilic emulsifier as “Duratan 60” without its chemical name. It is unclear what “Duratan 60” is. Appropriate correction is required. For examining purposes other non-ionic lipophilic emulsifiers will be assumed suitable.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

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Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 16 contains the trademark/trade name DURATAN. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe an emulsifier and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Lynch (U.S. Pat. No. 5,759,609). Lynch discloses a low-fat whipped topping comprising about 0-7wt% fat, 35 to 60% water and having an overrun between 300 and 500% (abstract, col 1 lines 59-65, col 2 lines 40-42). These ranges are within applicant's recited range. Lynch also discloses that the topping could be flavored with butter (col 6 lines 56-58).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claims 2-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lynch (U.S. Pat. No. 5,759,609) in view of Solms-Baruth et al (U.S. Pat. No. 3,763,900), Gonsalves et al (U.S. Pat. No. 6,372,280), Kocher (U.S. Pat. No. 2,831,775), Musser (U.S. Pat. No. 2,883,286),

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Viktorovna (RU 2180177), Pickenhagen et al (U.S. Pat. No. 6,025,005) and Dell et al (U.S. Pat. No. 4,251,560). With regard to claims 2-4, 27 and 29, Lynch failed to disclose packaging a flavored topping in aerosol container. However, Solms-Baruth et al teach an aerosol container filled with a sprayable or foamable product such as whipped cream in order to for the products to possess a long period of safe storage (abstract, col 4 lines 16-20, lines 43-45). It would have been obvious to one of ordinary skill in the art to modify Lynch with the teachings of Solms-Baruth et al by utilizing aerosol cans in order to preserve the products for a long period of safe storage. Lynch is silent as to the stability of the topping at room temperature after dispensing from the can. However, it would be obvious to one of ordinary skill in the art to expect that the product would remain stable as recited because Lynch discloses identical ingredients within the ranges as recited by applicant and it would be expected that the products would be identical.

14. With regard to claim 3, Lynch failed to disclose an aerosol container. Solms-Baruth et al teaches using an aerosol container to package milk products such as toppings. The Office does not have the capability to distinguish between the operation of the prior art's can and the instantly claimed container. It would be obvious to one of ordinary skill in the art to expect that the operation of both containers would allow removal of over 90% of the product as instantly claimed because they both utilize the same pressurizing agent and dispense the same type of product.

15. With regard to claim 4, Lynch failed to disclose the pressurizing agent. However, Solms-Baruth et al teach that for foodstuffs nitrous oxide is particularly suitable because of its neutral taste and its relative physiological inoffensiveness (col 3 lines 2-5). It would be obvious to one of

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ordinary skill in the art to modify Lynch with the teachings of Solms-Baruth et al by utilizing nitrous oxide because of its neutral taste.

16. With regard to claims 5 and 12-13, Lynch discloses a low calorie butter-flavored composition comprising from 35% to about 60% water (col 1 lines 59-60, claim 1), corn syrup from about 15% to about 20% (col 4 lines 8-10), it is well known in the art that corn syrup is a starch hydrosylate, milk powder and proteins from 0% to 10% (col 6 lines 26-27), and flavoring at less than 1% (see table 1). However, Lynch failed to disclose fat at a range from 13-16%. Gonsalves et al teach stable foams such as whipped topping having a fat content from about 5% to about 20% (col 5 lines 55-56). It would have been obvious to one of ordinary skill in the art to utilize the fat content taught by Gonsalves et al in order to provide a low-fat content product to satisfy consumer demands for low-fat food products.

17. With regard to claim 6, Lynch discloses soy flour as a protein source (col 6 line 25) and that many soy protein preparations are known in the art and may be used because of its solubility (col 6 lines 36-38). However, Lynch failed to disclose cheese whey or hydrogenated soy powder. It would be obvious to one of ordinary skill in the art to expect that soy protein encompasses soy powder and any soy protein would perform the same functions as recited by applicant.

18. With regard to claims 7-8 and 18-19, Lynch discloses a low calorie butter-flavored composition comprising corn syrup having a dextrose equivalent of about 15-65 (col 3 lines 65-66), it is well known in the art that corn syrup is a starch hydrosylate.

19. With regard to claims 9-10, Lynch discloses suitable fats in preparing whipped toppings including coconut fat (col 4 lines 27-32). However, Lynch failed to disclose the melting point of

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the coconut fat. It would be obvious to one of ordinary skill in the art to expect that the melting point would be the same as recited by applicant because it is the same ingredient.

20. With regard to claims 14-15 and 23-24, Lynch discloses that a wide variety of emulsifiers could be utilized from about 0.05% to about 5% (col 4 lines 64-67), non-ionic lipophilic and hydrophilic emulsifiers at less than 1%, lecithin at a range from 0.01% to 0.25%, microcrystalline cellulose at a range from 0% to 2% (col 5 lines 22-25, lines 33-59), salt at a range from 0% to 5% (col 6 lines 44-47) and colorants (col 6 lines 52-55). However, Lynch failed to disclose the amount for the colorant. It would be obvious to one of ordinary skill in the art to expect that the amount is an experimental result variable because amount depends on the color intensity preferred by the consumer.

21. With regard to claims 16 and 25, Lynch discloses microcrystalline cellulose as a suitable stabilizer (col 5 lines 47-54), a non-ionic lipophilic emulsifier such as glyceryl monostearate, sorbitan stearate, etc (col 5 lines 24-25), a non-ionic hydrophilic emulsifier such as polysorbate 60 (col 5 lines 25-26) and mono and diglycerides (col 5 line 16). However, Lynch failed to disclose annatto as a colorant. Kocher teaches an edible annatto coloring composition for coloring food products such as dairy, milk, ice cream etc (col 1 lines 15-20). It would have been obvious to one of ordinary skill in the art to utilize the annatto colorant taught by Kocher as a colorant because it is well known as a coloring material in the food industry.

22. With regard to claims 17 and 21, Lynch disclose corn syrup from about 15% to about 20% (col 4 lines 8-10), it is well known in the art that corn syrup is a starch hydrosylate and flavoring at less than 1% (see table 1). Lynch failed to disclose whole milk and heavy cream. However, Dell et al teach a cream containing whipped topping composition containing heavy

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cream at 62.5% (see col 5 lines 20-24). Musser teaches a foam topping containing whole milk from 35 to 45% (col 1 line 49). These ranges are within applicant's recited range. It would be obvious to one of ordinary skill in the art to modify Lynch by incorporating the ingredients taught by Dell et al and Musser in order to provide a product with attributes such as improved texture and mouth feel that is appealing to the consumer.

23. With regard to claim 22, Lynch does not disclose the ingredients and wt% as recited. However, it would be obvious to one of ordinary skill in the art to combine these ingredients to give a topping composition because these ingredients are well known in the art and it would be an experimental result variable to achieve the wt% based on texture, mouth feel and other attributes desired by the consumer.

24. With regard to claim 26, Lynch discloses a low calorie butter-flavored composition comprising from 35% to about 60% water (col 1 lines 59-60, claim 1), corn syrup from about 15% to about 20% (col 4 lines 8-10), it is well known in the art that corn syrup is a starch hydrosylate, milk powder and proteins from 0% to 10% (col 6 lines 26-27), and flavoring at less than 1% (see table 1) and having an overrun between 300 and 500% (abstract). However, Lynch failed to disclose fat at a range from 13-16%. Gonsalves et al teach stable foams such as whipped topping having a fat content from about 5% to about 20% (col 5 lines 55-56). It would have been obvious to one of ordinary skill in the art to utilize the fat content taught by Gonsalves et al in order to provide a low-fat content product to satisfy consumer demands for low-fat food products.

25. With regard to claim 28, Lynch disclose corn syrup from about 15% to about 20% (col 4 lines 8-10), it is well known in the art that corn syrup is a starch hydrosylate and flavoring at less

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than 1% (see table 1) and having an overrun between 300 and 500% (abstract). Lynch failed to disclose whole milk and heavy cream. However, Dell et al teach a whipped topping composition containing heavy cream at 62.5% (see col 5 lines 20-24). Musser teaches a foam topping containing whole milk from 35 to 45% (col 1 line 49). These ranges are within applicant's recited range. It would be obvious to one of ordinary skill in the art to modify Lynch by incorporating the ingredients taught by Dell et al and Musser in order to provide a product with attributes such as improved texture and mouth feel that is appealing to the consumer.

26. With regard to claim 30, Lynch failed to show the fat content of the heavy cream and whole milk. However, Dell et al teach a whipped topping composition containing heavy cream at 62.5% having a fat content of 40% (see col 5 lines 20-24). It is well known that whole milk has the full milk fat content of between 3-4%. It would have been obvious to one of ordinary skill in the art to utilize the heavy cream taught by Dell having a fat content of 40% which is about 38% as recited by applicant in order to provide a product with attributes such as improved texture and mouth feel that is appealing to the consumer.

27. With regard to claims 11 and 20, Lynch failed to disclose the flavor composition. Viktorovna teaches a flavoring agent comprising of maltol, acetoin, diacetyl, gamma-nonolactone, butyric acid, caproic acid, and lactic acid at lower wt% (abstract). However, Viktorovna failed to show propylene glycol. Pickenhagen et al teach flavor substances comprising propylene glycol (see example 4) where it is utilized as a solvent. It would be obvious to one of ordinary skill in the art to utilize the teachings of Pickenhagen et al and Viktorovna in Lynch in order to provide a flavor composition as instantly claimed. The wt% of the ingredients is an experimental result variable that can be adjusted based on batch size.

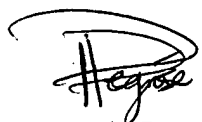
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Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Thompson (U.S. Pat. No. 3,230,091) and Dell et al (U.S. Pat. No. 4,451,492). Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adepeju Pearse whose telephone number is 571-272-8560. The examiner can normally be reached on Monday through Friday, 8.00am - 4.30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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